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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,860	09/25/2003	Koichi Ito	2487	8675

7617 7590 08/11/2005

BRUZGA & ASSOCIATES  
11 BROADWAY, STE 400  
NEW YORK, NY 10004

EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/671,860

Applicant(s)

ITO, KOICHI

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) 1-51, 58-77, 82-101, 103, 109 and 112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-57, 78-81, 102, 104-108, 110 and 111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 54-57, 80, 81 and 110 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 7/5/2005. Applicants' amendments to elected claims 52, 54, 55, 78, 80, 81, 102, 104-108 and 110; and amendments to withdrawn claims 58, 59, 61, 62, 64, 65, 67, 68, 70, 71, 73, 74, 76, 77, 82-86, 88, 89, 91-95, 97, 98, 100, 101 and 103 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicant's amendment is sufficient to overcome the rejections in sections 5 and 7 of Office action dated 5/26/2005.

### ***Election/Restrictions***

4. Applicant's request for reconsideration of the finalization of the restriction requirement is acknowledged. With respect to Applicant's argument "applicant maintains that co-extrusion is not part of applicant's invention nor is it alluded to or even speculated upon in applicant's specification. The concept of co-extrusion ... raised by Examiner ... must be substantiated by the Examiner, not by applicant" (Remarks, page 18, second paragraph), the Examiner repeats that Inventions Group I and Group II are related as process of making and product made, since the product as claimed can be

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made by another and materially different process, such as coextrusion (see restriction requirement dated 2/9/2005), and also these inventions are distinct and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper (see Office action dated 5/16/2005, page 2). The Examiner respectfully notes that Applicant fails to appreciate that to overcome the restriction requirement, Applicant must present sufficient evidence and/or reasoning that why the alternative process would not be able to make the product as claimed, and the Examiner repeats that, in the absence of any evidence and/or reasoning, merely stating 'no substantial example' is insufficient to overcome the restriction requirement.

Further, Applicant's argument "the provisions of 37 C.F.R. 1.141(a) require that the inventions in question be both independent and distinct in order to be divided" (Remarks, page 19, top paragraph) has been carefully considered, but is not persuasive. The Examiner asserts that, in the absence of evidence to the contrary, Inventions Group I and Group II are distinct and independent, as set forth above, Applicants' argument to the contrary notwithstanding.

The requirement is still deemed proper and its finality is maintained.

5. Applicant correctly pointed out that claim 102 is an elected species (Remarks, page 20, first full paragraph), as such it is now included as an elected claim. In summary, the elected claims are 52-57, 78-81, 102, 104-108, 110 and 111.

6. Upon further consideration, it is noted that species (1) polyvinyl alcohol and (2) polyvinyl alcohol/polyvinyl acetate is restrictable. It should be noted that the general test as to when claims are restrictable to different species is the fact that one claim

recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. See MPEP 806.04(f). In the present application, species polyvinyl alcohol is recited in claims 54, 55, 80, 81 and 110, but not in claims 56 and 57.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (1) or (2) as set forth above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Claims not mutually elected will be withdrawn.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Claims 52-57, 78-81, 102, 104-108, 110 and 111 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More particularly, in newly amended independent claim 52, the recitation, *inter alia*, "... said coating comprising (i) a ... film forming, primary layer ... wherein the –NCO group of the secondary layer is reacted with the –OH group of the primary layer compound in the primary layer's non-aqueous dry state ..." is considered as failing to comply with the enablement requirement, because the specification explicitly discloses that "The extent of drying should be substantially complete so as to avoid the formation of blisters or bubbles in the film layer after the polyurethane paint is applied to the primary layer." (specification, page 18, lines 9-12). As such, since the recitation "film forming" inherently implies that the primary layer is not substantially dried, the amended independent claim 52 is still not enabled. In passing, the Examiner would like to remind Applicant that amended claim 52 appears to be directed to an intermediate state of an

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intended finally dried article, because the secondary layer is recited as a "film-forming coating" (see last line of claim 52), i.e., not a dried film.

Similarly, in independent claim 78, the recitation, *inter alia*, "... said film forming layer comprising a compound that includes at least one -OH reactive group ..." fails to comply with the enablement requirement, as set forth above.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making a coated polyurethane product.

DD 136589A is directed to a molded soft polyurethane foam. The foam inserts are coated with a plastics dispersion, pref. polyvinyl acetate or PVC latex or mixtures.

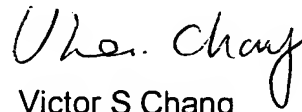
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Victor S Chang".

Victor S Chang  
Examiner  
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8/8/2005